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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/561,175

02/16/2006

Frederic Henot

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EXAMINER

WEN, SHARON X

ART UNIT

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1644

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,175	Applicant(s) HENOT ET AL.	
	Examiner SHARON WEN	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-17, 22, 23 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17, 22-23 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after Final Rejection. Since this application is eligible for continued Examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 10/28/2008 has been entered.

2. Applicant's amendment, filed 02/10/2009, has been entered.

Claims 1-14, 18-21 and 24-26 have been canceled.

Claims 15-17, 22-23 and 27-30 are pending and currently under examination as they read a pharmaceutical composition comprising grass allergen as the elected species.

Upon further consideration, the examination has been extended to tree allergen.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 16-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16-17 recite the limitation "said substance" in base claim 15. There is insufficient antecedent basis for this limitation in the claim.

Applicant is reminded that any amendment must point to a basis in the specification so as not to add New Matter. See MPEP 714.02 and 2163.06.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 15-17, 23, 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Focke et al. (U.S. Patent 7,244,431 B2, see entire document).

It is noted that Applicant elected grass allergen as the specific antigen in the claimed pharmaceutical composition. However, given the applicability of the prior art under 103(a) and the broadest reasonable interpretation of the claims, the following grounds of rejection are set forth.

Focke et al. taught a pharmaceutical composition comprising a peptide (i.e., a birch tree allergen) having a molecular weight (MW) of less than 10 KDa wherein the peptide is a fragment of a protein (see, e.g., claim 1 and column 2, lines 62-67). It is noted the prior art peptide recited in claim 1 would have a MW of less than 10 kDa, given that it is 8 to 50 amino acids in length and that an amino acid has the average MW of 135 dalton. Therefore the peptide taught by the prior art inherently weighs less than 10 KDa. Furthermore, the prior art taught the amount of the peptide in the pharmaceutical composition to be in the range of 0.001-1000 ug and 1-100 ug (see, e.g., column 3, lines 44-47). Lastly, the prior art taught the pharmaceutical composition to be formulated for sublingual, oral or nasal administration which reads on buccal and enteric administration as recited in the present claims, under the broadest reasonable interpretation (see paragraph bridging columns 3-4).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The previous rejection under 35 U.S.C. 103(a) as being unpatentable over Pradalier et al. (Allergy 1999, 54:819-828) in view of Ball et al (U.S. Patent 6,559,120, reference of record) Ćirković et al. (Allergy 1999, 54:128-123, reference of record), Malley (U.S. Patent 4,215,036, reference of record) and Marx (U.S. Patent 5,898,037, reference of record) has been withdrawn in view of Applicant's amendment, filed 02/10/2009. However, the following New Grounds of Rejection are set forth herein.

9. Claims 15-17, 22, 23 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Focke et al. (U.S. Patent 7,244,431) and Marx (U.S. Patent 5,898,037, reference of record).

The teaching of Focke et al. has been discussed supra (see above).

The only differences between Focke et al. and the present claims are 1) Focke did not explicitly teach grass allergen as the specific antigen in the claimed pharmaceutical composition and 2) Focke et al. did not teach adding nucleoside triphosphates in the pharmaceutical composition.

Regarding grass allergen, the following is noted:

Even though Focke did not explicitly teach grass allergen, Focke stated that "allergenic proteins that can be envisaged are e.g. the major grass pollen..." (see column 2, lines 31-32). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention was made, upon reading Focke et al, to substitute grass allergen for birch allergen (a tree allergen) in an allergy vaccine preparation for the same purpose of treating allergic disorders.

Furthermore, it would be obvious to pick from a finite number of identified allergens to try as taught by Focke et al. because, with a reasonable expectation of success, a person of ordinary skill has good reason to pursue the known options (e.g. preparing a pharmaceutical composition comprising a peptide/allergen that is less than 10 KDa and known allergens such as grass allergen, tree allergen, etc.) within his or her technical grasp. This leads to the anticipated success of making a pharmaceutical composition comprising a grass allergen that is less than 10 KDa. It is likely the product not of innovation but of ordinary skill and common sense.

Regarding nucleoside triphosphates, the following is noted:

Nucleoside triphosphates, such as ATP, were well-known adjuvants in a pharmaceutical composition formulated for treating allergic disorders as evidenced by Marx (see entire document, in particular, Detailed Description of Preferred Embodiments). Specifically, Marx teaches that ATP, a nucleoside triphosphate, is a preferred adjuvant in a composition suitable for treating allergic skin condition which reads on allergic reaction as *a species reads on a genus* (see column 5, lines 4-10 and lines 52-55).

Given the teaching by Pradalier on the pharmaceutical composition comprising grass allergen for treating allergic reaction and the teaching by Marx on using ATP as an adjuvant for immunotherapy associated with allergic reaction, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make a pharmaceutical composition comprising grass allergen and nucleoside triphosphates such as ATP for immunotherapy associated with allergic reaction.

Furthermore, given the teaching by Focke et al. that the aim of the sublingual immunotherapy with grass allergens is to elicit protective antibody production (see column 1, lines 35-37), and that the teaching by Marx that ATP is a preferred adjuvant for treating allergic conditions (see column 5, lines 4-10 and lines 52-55), one of ordinary skill would have been motivated to add nucleoside triphosphates such as ATP

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in a pharmaceutical composition comprising grass allergen for sublingual immunotherapy.

Therefore, the invention, as a whole, was *prima facie* obvious to one of ordinary skill in the art, at the time the invention was made as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

10. No claim is allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHARON WEN whose telephone number is (571)270-3064. The examiner can normally be reached on Monday-Thursday, 8:30AM-6:00PM, ALT. Friday, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen O'Hara can be reached on (571)272-0878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sharon Wen/

Examiner, Art Unit 1644

February 23, 2009

/Phillip Gambel/

Primary Examiner

Technology Center 1600

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February 26, 2009